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PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yukihiro TATSUNO et al.

Group Art Unit: 3618

Application No.: 10/528,485

Examiner: B. AVERY

Filed: March 21, 2005

Docket No.: 123254

For: PRIME MOVER CONTROL DEVICE OF CONSTRUCTION MACHINE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the June 24, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 9 and 11-16, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. See MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after

taking the prior art into consideration. See MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of a *priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If a *priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Applicants respectfully submit that there exists *a priori* unity of invention with respect to claims 9 and 11-16 (Group I) and claims 10 and 17-21 (Group II), by the fact that independent claims 9 and 10 share common subject matter. Accordingly *a priori* unit of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. See ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 9 and 10 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/mab

Date: July 23, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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